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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,066	07/17/2000	Veronique Ferrari	05725.0656-00	8522

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER	
SHEIKH, HUMERA N	

ART UNIT	PAPER NUMBER
1615	25

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/618,066	FERRARI ET AL.	
	Examiner	Art Unit	
	Humera N. Sheikh	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45,47-67,69-113 and 118-167* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-45,47-67,69-113 and 118-167* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *23* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Status of the Application

Receipt of the Supplemental Information Disclosure Statement (IDS) filed 06/23/03 and the Request for Reconsideration filed 09/10/03 is acknowledged.

Claims 1-45, 47-67, 69-113 and 118-167 are pending. Claims 1-45, 47-67, 69-113 and 118-167 are rejected.

Claim Objections

Claims 47-61 and 69 are objected to because of the following informalities: Claims 47-61 are dependent upon cancelled claim 46 and claim 69 is dependent upon cancelled claim 68. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-45, 47-67, 69-113 and 118-167 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-188 of copending Application No. 09/685,577 in view of Iwano *et al.* (US Pat. No. 4, 952,245).

This is a provisional obviousness-type double patenting rejection.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the same subject matter has been claimed.

The instant claims (1-45, 47-67, 69-113 and 118-167) are drawn to a structured composition comprising at least one dyestuff, at least one continuous liquid fatty phase wherein the fatty phase is structured with at least one structuring polymer which has a weight-average molecular mass ranging up 30,000 and comprises a polymeric skeleton comprising at least one non-pendant hetero atom and at least one fatty chain, wherein the fatty chain comprises at least one hetero atom and said structured composition is in the form of a wax-free solid and wherein said at least one dyestuff, said at least one continuous liquid fatty phase and said at least one structuring polymer form a physiologically acceptable medium. Claims 1-188 of co-pending Application No. 09/685,577 are drawn to a similar invention.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the only distinction observed between the instant claims and co-pending application (09/685,577) is that the instant claims are directed to a structured composition comprising a non-pendant hetero atom and is pertained to a "dermatological composition", whereas co-pending application (09/685,577) comprises a hetero atom and includes the term "cosmetic".

The instant claims 1-45, 47-67, 69-113 and 118-167 are generic in relation to the species of the 09/685,577 co-pending application. Furthermore, the instantly claimed species embraced in the 09/685,577 application are embodied in the generic instant claims of the 09/618,066 application. The instant invention is broader in scope than the said co-pending application because the instant invention is generic, whereas specific species are mentioned in co-pending 09/685,577, making the claims narrower in scope. The species of the 09/685,577 application renders the generic 09/618,066 application unpatentable.

The term "structured *cosmetic* composition" used in 09/685,577 would not in any manner distinguish from the "dermatological composition" of 09/618,066 since it is the patentability of the composition *per se*, that must establish patentability.

The secondary reference (Iwano *et al.* US '245) is relied upon to show that it would be obvious to use the particular and conventional pigments and nacres as dyestuffs in cosmetic and dermatological formulations.

Non-Statutory Obviousness-Type Double Patenting: Rejection Based on Anticipation

Claims 1-45, 47-67, 69-113 and 118-167 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-75 of U.S. Patent No. 6,402,408 B1. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because similar subject matter has been claimed. The instant claims are drawn to a structured composition comprising at least a) one dyestuff, b) at least one continuous liquid fatty phase wherein the fatty phase is structured with at least one structuring polymer which has a weight-average molecular mass ranging up 30,000 and comprises a polymeric skeleton comprising at least one non-pendant hetero atom and at least one fatty chain, wherein the fatty chain comprises at least one hetero atom and said structured composition is in the form of a wax-free solid and wherein said at least one dyestuff, said at least one continuous liquid fatty phase and said at least one structuring polymer form a physiologically acceptable medium and claims 50-56 which are drawn to c) amphiphilic compounds whereas,

claims 1-75 of U.S. Patent No. 6,402,408 B1 are also drawn to a structured composition comprising: a) at least one liquid fatty phase comprising: at least one structuring polymer comprising a polyamide skeleton which comprises at least one end group with at least one chain chosen from alkyl chains comprising at least four carbon atoms and alkenyl chains comprising at least four carbon atoms, bonded to the skeleton via at least one ester group; and b) at least one amphiphilic compound which is liquid at room temperature and which has an HLB value of less than 8 and c) claims 34-37 of Patent 6,402,408 B1 are drawn to a composition comprising at least one dyestuff. The composition can be in varied cosmetic forms, such as a mascara product, eyeliner, a foundation, lipstick, deodorant, make-up product for the body, make-up removing product, eyeshadow, face powder, concealer, treating shampoo, hair conditioning product, an antisun product or a care product for the face or body. Therefore claims 1-45, 47-67, 69-113 and 118-167 of the instant application are anticipated by claims 1-75 of U.S. Patent No. 6,402,408 B1 because the scope is the same.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-45, 47-67, 69-113 and 118-167 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavlin *et al.* (US Pat. No. 5,998,570) in combination with Iwano *et al.* (US Pat. No. 4, 952,245).

Pavlin *et al.* teach a low molecular weight, resin composition and methods for preparing the resin composition, which comprises ester-terminated polyamides of polymerized fatty acids useful in formulating transparent gels in low polarity liquids. The gel contains about 5-50% ester-terminated polyamide. The gels are useful in formulating personal care products (see Abstract). The invention also includes articles of manufacture of comprising ester-terminated polyamides. Such articles include antiperspirants and cosmetics, as well as other personal care products, such as deodorant, eye make-up, lipstick, foundation make-up, baby oil, make-up removers, lip balm and the like (col. 3, lines 43-58). Pavlin teaches that suitable esters are those commonly employed in the cosmetics industry for the formulation of lipstick and make-up (col. 16, lines 32-53).

Pavlin teaches that pure hydrocarbon is desirably included in the personal care composition because it is transparent and relatively inexpensive. Pure hydrocarbons are available in a variety of viscosities and grades (col. 2, lines 19-30).

At column 15, lines 32-45, Pavlin teach that a preferred low polarity liquid is a hydrocarbon, with preferred hydrocarbons being solvents and oils. Oils are preferred in most personal care formulations, and thus are preferably used in forming the gels of the invention. The hydrocarbon has a relatively high number of carbon atoms, for example, 10 to 30 carbon atoms, and thus is not a volatile hydrocarbon.

The difference between the instant application and the patent is that Pavlin does not teach a dyestuff chosen from pigments and nacres in the resin composition.

However, Iwano *et al.* teach a cosmetic composition comprising a nacreous pigment containing a dye, which possesses excellent external distinctness, luster, high safety and excellent stability. The cosmetic compositions comprising the nacreous pigment containing a dye are in the form of a lipstick, eye shadow, rouge, nail enamel, eye liner, eye pencil, mascara, and the like (see Abstract, column 1, line 1 – col. 2, line 25; and col. 5, lines 22-56).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Iwano et al. within Pavlin et al. because Iwano et al. teach cosmetic compositions that comprise nacreous pigments that contain dyes wherein cosmetics include lipstick, eye shadow, rouge, nail enamel, eye liner, eye pencil, mascara, and the like and similarly Pavlin et al. teach cosmetic

and personal care product compositions that include eye make-up, lipstick, foundation make-up, make-up removers, lip balm and the like. The expected result would be a cosmetic composition comprising dyestuffs, nacres and pigments that yield excellent color characteristics, such as luster, brightness along with excellent stability. The motivation to combine the ingredients flows logically from the art. This is a prima facie case of obviousness.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (703) 308-4429. The examiner can normally be reached on Monday through Friday from 7:00A.M. to 4:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

hns
November 12, 2003